

REMARKS/ARGUMENT

Claim Status

Claims 94-183 are pending. Claims 164 and 176 are withdrawn from consideration. Claims 94-163, 165-175, and 177-183 are under examination.

Rejection under 35 U.S.C. §112, Second Paragraph

Claims 94-163, 165-175, and 177-183 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. For the following reasons, the rejections are respectfully traversed.

The Examiner contended that “[t]he claims are directed to a ‘manufacturing method...for the application of a coating substance’....” She also contended that “[t]here are no active method steps of applying a coating substance and it is unclear if Applicant requires a coating step.”

The Examiner was incorrect in contending that the language “for the application of a coating substance” defines the term “manufacturing method.” In claim 94, for example, the language “for the application of a coating substance” defines the step of “causing a coating dispenser to be moved.” The Examiner deleted the language “causing a coating dispenser to be moved” to make it appear that the language “for the application of a coating substance” defines the term “manufacturing method.”

The Examiner was also incorrect in requiring the claims to include the step of applying a coating substance. Neither the specification nor Applicants specify that the step of applying a coating is critical or essential for the claimed invention. *MPEP* 2164.08(c) and 2172.01 (a rejection based on the ground that a critical or necessary limitation is missing should be made only when the language of the specification or a statement by Applicant makes it clear that the limitation is critical or essential for the invention).

It is not clear why the Examiner requires the claims to include “active” steps. The Examiner cited no legal authority for the requirement. The Examiner also cited no definition of an “active” step and did not explain why the step of “causing” is not an “active” step while the step of “applying” is.

The Examiner further contended that the step of “causing” is so broad as to be meaningless. However, a broad limitation does not make a claim indefinite under 35 U.S.C. §112.

Finally, the Examiner suggested that “a coating operation method step” be included in the claims. As stated above, such a step is not critical or essential for the claimed invention and therefore need not be included in the claims.

Rejection under 35 U.S.C. §102

Claims 110, 111, 114, 117-120, 125, 126, 132, 156, and 159 were rejected under 35 U.S.C. §102(b) as being anticipated by *Tuch* (U.S. Patent 5,679,400). For the following reasons, Applicants respectfully request reconsideration and withdrawal of the rejection.

Independent claim 110 recites, *inter alia*, avoiding “the application of the coating substance in a space between the frame structures.” The other rejected claims depend from claim 110 and therefore indirectly recite this limitation.

The Examiner contended that *Tuch* teaches this limitation. Specially, the Examiner contended that “*Tuch* teaches coating a stent with a dispenser using spray bursts” and “[b]etween spray bursts, there is a time delay during which the stent is moved or rotated....” According to the Examiner, the “movement of the stent occurs between coating bursts, therefore, the movement avoids application of coating substance in a space between frame structures because, in fact, during this time of movement, application is avoided altogether.”

Applicants respectfully disagree with the Examiner’s contention that *Tuch* teaches avoiding “the application of the coating substance in a space between the frame structures.” *Tuch* teaches stopping spraying between spraying bursts to rotate the stent, but the spraying is not stopped to avoid “the application of the coating substance in a space between the frame structures.” In fact, when the spraying is resumed, it is almost inevitable that the coating substance will be applied in a space between the frame structures by the time the step-by-step spraying process of *Tuch* is completed.

Stopping spraying altogether, as is done in *Tuch*, is different from avoiding “the application of the coating substance in a space.” Using the logic that stopping spraying altogether means avoiding spraying into a space, one would reach the absurd conclusion that

stopping spraying altogether means avoiding spraying onto the stent and *Tuch* teaches avoiding applying a coating to the stent.

The Examiner also argued that "*Tuch* teaches coating only one half of the stent at a time, therefore, coating is not applied in 'a space' of the end not being coated." This argument is flawed for the same reasons as set forth in the previous three paragraphs.

Rejection under 35 U.S.C. §103(a)

Claims 94, 95, 98, 101, 102, 103, 109, 130, 140, 141, 154, 158, 159-163, 165-167, 172-175, and 177-179 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Tuch*. For the following reasons, Applicants respectfully request reconsideration and withdrawal of the rejection.

Independent claim 94 share the limitations, discussed above, with independent claim 110. Therefore, independent claim 94 and the claims depend therefrom are patentable over *Tuch* for the same reasons.

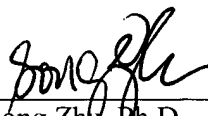
The rejections of independent claims 160 and 172, and of the claims depend therefrom, are improper because the Examiner failed to address specifically any of the claimed limitations.

In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If necessary, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 07-1850.

Respectfully submitted,

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Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza
Suite 300
San Francisco, CA 94111
Facsimile (415) 393-9887
Telephone (415) 954-0241
szhu@ssd.com



Song Zhu, Ph.D.
Attorney for Applicants
Reg. No. 44,420